



PATENT  
2801-0165P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In application of: Before the Board of Appeals

Russell M. HAGAN et al.

Appeal No.:

Appl. No.: 09/985,679

Group: 1617

Filed: November 5, 2001

Examiner: S. WANG

Conf.: 4024

For: NOVEL MEDICAL USE FOR TACHYKININ ANTAGONISTS

REPLY BRIEF UNDER 37 C.F.R. §41.41

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**MS APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

April 8, 2005

Sir:

The present Reply Brief is submitted in response to the Examiner's Answer issued on February 9, 2005.

In the Examiner's Answer, the Examiner has reinstated the rejection of claims 1, 3-9, 11-19 and 25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U. S. Patent No. 6,326,383. Since this rejection was not stated in the Final Rejection, this rejection is being treated as a new ground of rejection. In essence, the Examiner has stated that the "generic" claims of

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the present application are unpatentable over the "species" (or sub-generic) claims of the '383 patent.

In response to this new ground of rejection, submitted herewith is a Terminal Disclaimer, which disclaims the terminal part of any patent granted on the above-identified application that would extend beyond the expiration date of the full statutory term as presently shortened by any Terminal Disclaimer of U. S. Patent 6,326,383.

Appellants hereby confirm the telephone conversation with Examiner Wang on January 31, 2005, wherein Examiner Wang inquired as to whether a Terminal Disclaimer had been filed in the present application with respect to U.S. Patent 6,326,383. Examiner Wang was advised that a Terminal Disclaimer had not been filed. Examiner Wang was also advised that after the Appeal Brief in this application was filed, a further continuation of the present application, Application No. 10/990,462, was filed which contains claims that are related to the claims in the present application. Appellants will take appropriate action in Application No. 10/990,462 to avoid or overcome any double patenting or obviousness-type double patenting issues.

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**Reply Brief**

**Summary**

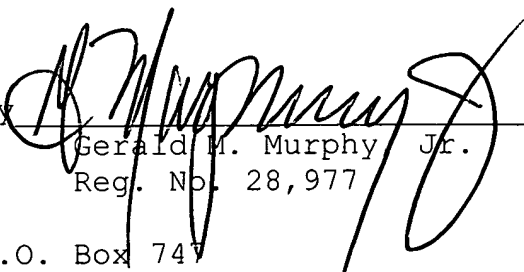
Appellants stand by their arguments that the rejection under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn. As to the obviousness-type double patenting rejection, as stated above, this rejection should be overcome by the Terminal Disclaimer filed concurrently herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees.

Respectfully submitted,

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By



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Enclosure: Terminal Disclaimer